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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,543	07/27/2001	Konrad Basler	Q-60361	9256

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EXAMINER

LACOURCIERE, KAREN A

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8-17

**Advisory Action****Application No.**

09/915,543

**Applicant(s)**

BASLER ET AL.

**Examiner**

Karen A. Lacourciere

**Art Unit**

1635

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 27 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
 2. ☒ The proposed amendment(s) will not be entered because:  
 (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ they raise the issue of new matter (see Note below);  
 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
 4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 71-78.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
 10. ☐ Other: \_\_\_\_\_

*Karen A. Lacourciere*  
 KAREN A. LACOURCIERE, PH.D.  
 PRIMARY EXAMINER

Karen A. Lacourciere  
 March 8, 2004

Continuation of 2. NOTE: The proposed amendment filed 02-27-2004 introduces the new limitation "inhibits tcf-driven luciferase activity" in place of the limitation "blocks Lgs function". Although this activity may be encompassed in the term "Lgs function" this function is a much narrower limitation than the previously examined limitation of Lgs function and would require a new search and further consideration. The proposed amendment to claim 71 cancels an "or" in line 6 of the claim, which introduces new considerations under 3 USC 112, second paragraph, as to the clarity of the claim, e.g. whether (i) and (ii) are meant in the alternative or if the claimed polypeptide is required to meet all of the limitations of (i) and (ii). If the polypeptide does need to meet all of the limitations of (i) and (ii), it would require a new search. The proposed amendments to claim 75 introduce new limitations into the prior claimed polypeptide of claim 73 and would require new considerations and a new search to determine if the claimed chimeric molecules are anticipated or obvious.

Continuation of 3. Applicant's reply has overcome the following rejection(s): If entered, Applicant's reply would overcome the rejection of record under 35 USC 102, as anticipated by Tang et al. because the specification demonstrates that the function of "inhibit tcf-driven luciferase activity in colon cancer cells" is not a property of the polypeptide of Tang et al. The proposed amendments have not been entered, however, and therefore the rejection is maintained.

Continuation of 5. does NOT place the application in condition for allowance because: In response to the rejection of record under 35 USC 112, first paragraph, Applicant argues that the claimed polypeptides are described because the critical part of the invention lies with the HD1 or HD2 homology regions, which are claimed by sequence and function. This is not found to be persuasive because the claimed function of "blocking Lgs function" is so broad that it would include activities that would require the sequence of the larger, undescribed polypeptides. Further, Applicant's arguments discuss a relatively small number of polypeptides encompassed in the claims, for example, changes of 19 amino acids, etc., however, the number of species encompassed in the claims is much larger than Applicant asserts, particularly since the claims include limitations wherein the claimed polypeptide comprises a fragment of the peptide with 90% homology to the disclosed species. Applicant further argues that the additional sequence of the larger polypeptide is not critical and that the 90% homology refers to the specific peptide and not the larger polypeptide and that the claims do not encompass e.g. fragments which comprise the binding site for a Lgs polypeptide with as little as one amino acid in common with the species described in the specification. Given that the claims include limitations wherein the polypeptide comprises a fragment of the peptide with 90% amino acid identity to the one disclosed species.